

### **REMARKS**

In the Office Action, claims 1, 7-10, 23 and 24 were rejected and claims 2-6 and 25-29 were objected to. By the present Response, claims 1, 23 and 24 are amended, claims 11-22 are canceled, and claims 31-36 are added. Upon entry of the amendments and new claims, claims 1-10 and 23-36 will remain pending in the present patent application. Reconsideration and allowance of all pending claims is requested.

### **Objections to the Title**

The Examiner objected to the title and suggested a new title. By this Response, the title has been amended in accordance with Examiner's suggestion to read "Method of Manufacturing an Electric Motor". Accordingly, Applicants respectfully request removal of the objection to the title.

### **Objections to the Claims**

Examiner objected to claim 24 because it previously depended upon a subsequent claim 25. By this Response, claim 24 has been amended to depend from claim 23. Thus, Applicants respectfully request removal of the rejection to claim 24.

### **Rejections Under 35 U.S.C. § 102**

Examiner rejected claims 1, 7, 8, 23 and 24 as being anticipated under 35 U.S.C. § 102(b) by Keck (U.S. Patent No. 5,519,273, hereinafter "Keck"). Applicants respectfully traverse this rejection. A *prima facie* case of anticipation under 35 U.S.C. § 102 requires a showing that each limitation of a claim is found in a single reference, practice or device. *In re Donohue*, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

With respect to claim 1, Keck fails to teach or even suggest several features that are discussed below. First, claim 1 recites, *inter alia*, "*extruding* a portion of a conduit box to form a hollow extension". (Emphasis added). Keck does not disclose anything that can properly be construed as "extruding." In rejecting claim 1, the Examiner stated

that Keck discloses “extruding or forming a portion of a conduit box (Cf. Fig. 4, 12; col. 5, lines 6 ff.) to form a hollow extension (Cf. fig. 4, 26 or Fig. 2, 24 & 44).” In fact, Keck discloses attaching a fitting to a motor housing wherein a groove portion of the fitting is placed on a notched part of the motor housing. *See, e.g.,* Fig. 2, col 5, lines 15-18. Once the fitting is in place, an endplate to the motor housing is placed over the end of the motor housing. *See, e.g.,* Fig. 6, col. 5, lines 48-51. While securing the endplate into position, crushable projections that are positioned on the fitting facing the endplate are deformed as the endplate is tightened down. *See, e.g.,* Fig. 6, col. 5, lines 50-54.

In sharp contrast to claim 1, in Keck the fitting is formed *by injection molding*. *See*, col. 5, lines 6-9. Injection molding generally is a process where a mold is filled with melted resin, the resin is cooled to allow it to set and then removed from the mold to reveal an object that mirrors the shape of the internal cavity of the mold. *See generally*, col. 5, lines 6-9. As compared to the “extruding” process disclosed in the present application, injection molding is both laborious and time consuming, not to mention that it is a completely different process. Indeed, “forming” and “extruding” have very separate and distinct meanings in the context of the Keck reference and the present application. Therefore, the injection molding formation of Keck cannot read on “extruding” in the present application and claims.

Secondly, as currently amended, claim 1 recites in pertinent part, “permanently plastically deforming the extension after the extension is inserted through the first hole to *form a flange thereby to prevent withdrawal* of the extension through the first hole.” (Emphasis added). The Examiner stated in the rejection that Keck discloses “permanently plastically deforming the extension by deforming the crushable projections (Cf. Fig. 2, 46A-D; col. 5, lines 50 ff.) after the extension is inserted through the first hole to prevent withdrawal of the extension through the first hole.” The “crushable projections” are positioned on only one side of a fitting and are crushed down against

themselves by the endplate, as explained above. *See, e.g.,* col. 5, lines 21-23 and 50-54; Figs. 2, 5 and 6.

The Examiner appears to have focused on deforming of the “crushable projections” in the Keck reference apparently as the equivalent of “plastically deforming the extension” of claim 1. However, the deforming of the “crushable projections” in Keck does not form a flange and does not prevent withdrawal but only provides a snug fit between the endplate and an intermediate portion of the fitting. *See, e.g.,* col. 5, line 65 to col. 6, line 3. It is placing of the fitting in the motor housing so that the notch of the motor housing and the groove of the fitting line up, combined with the tightening of the endplate that prevents the fitting from withdrawal in the Keck arrangement. Therefore, the crushable projections of Keck not only are different structurally, but also functionally, and cannot properly read on the flange recited in claim 1 of the present application.

Similarly, claim 23 recites, “plastically deforming the extension *to form a flange* that captures the motor housing between the flange and the bottom of the conduit box to secure the conduit box to the motor housing.” (Emphasis added). As discussed above with respect to claim 1, Keck does not disclose the formation of a flange. The deformation of the “crushable projections” of Keck simply flattens them onto themselves and serves to make a tight fit. *See, e.g.,* col. 5, line 65 through col. 6, line 3.

Additionally, the flange in claim 23 “captures the motor housing between the flange and the bottom of the conduit box to secure the conduit box to the motor housing.” The deformation of the “crushable projections” of Keck, to contrast, does not capture anything nor does it secure the fitting to the motor housing. Rather, it only makes a tight fit to keep out water, oil and dirt. *See, e.g.,* col. 5, line 65 to col. 6, line 3. It is the pressure of the endplate tightened against the motor housing combined with the notched portion of the motor housing being positioned into a groove in the fitting that holds the

fitting in place. *See, e.g.,* Fig. 6, col. 5, lines 50-54. Therefore, Keck discloses nothing functionally or structurally equivalent to the flange recited in claim 23.

For the reasons discussed above, Applicants respectfully request that the rejections of claims 1 and 23 be withdrawn and that the claims be allowed. Furthermore, Applicants request that the rejections of claim 7, 8 and 24 be withdrawn and allowed also as they are dependent from claim 1 and 23. Additionally, Examiner objected to claims 2-6 and 25-29 as being dependent upon a rejected base claim. In light of the foregoing, Applicants also request allowance of claims 2-6 and 25-29, upon the allowance of claims 1 and 23.

#### **Rejections Under 35 U.S.C. § 103**

The Examiner rejected claims 9 and 10 as being unpatentable under 35 U.S.C. § 103(a) over Keck. Applicants respectfully traverse these rejections.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination.

*Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Claims 9 and 10 depend from claim 1. As discussed above, Keck does not disclose all of the elements recited in claim 1. Accordingly, Applicants respectfully submit that claim 9 and 10 are allowable based on their dependency on an allowable base claim. Applicants respectfully request withdrawal of the Examiner's rejection under 35 U.S.C. § 103 and allowance of claim 9 and 10.

#### **New Claims**

By this Response, new claims 30-36 are added, of which only claim 30 is independent. These claims are believed to be clearly patentable for the reasons summarized above with respect to claim 1 and 23. Their consideration and allowance are kindly requested.

**Conclusion**

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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